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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,868	02/11/2004	Natalino Zanchetta	POLY-102-CIP-2	3901

7590 09/23/2005

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EXAMINER	
AHMAD, NASSER	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,868	ZANCHETTA ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2, 5, 7-8, 13, 17-19, 21-22, 24-26, 31, 33-34 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fensel (6641896) in view of Braga (6284820).

Fensel relates to a self-adhering underlayment (10) comprising a carrier sheet (12) being sandwiched between a top layer (14) and a bottom layer (14). The carrier is dual-compound composite because it comprises glass fiber treated with fire retardant or binder (abstract). The top and bottom layers comprise modified bitumen mixture which is an asphalt modified with SBS, SIS and tackifier (col. 2, lines 22-34). The top layer upper surface is provided with granular material such as coal slag aggregate (col. 2, lines 40-42). As shown in figure-1, the adhesive surface is provided with a release liner film (20). However, Fensel fails to teach that the top layer contains polypropylene modifiers. Braga discloses a bituminous composition for roofing surfaces and comprises a mixture of bitumen with ethylene-propylene co-polymer, atactic polypropylene, polyethylene and isotactic propylene (col. 1, lines 57-63). Therefore, it would have been obvious to one having ordinary skill in the art ti utilize Braga's teaching of using the

modified bitumen composition in the invention of Fensel with the motivation to provide for resistance to aging and enhanced elastic properties.

With regard to the particular composition as recited, it would have been obvious to one having ordinary skill in the art to modify Fensel or Braga, based on optimization through routine experimentation, to optimize the adhesive and elastic characteristics.

3. Claims 3-4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fensel in view of Braga and Yamaguchi (5686703).

Fensel and Braga, as discussed above, fails to teach the presence of polyvinyl Butyral as the tackifying resin in the bottom layer. Yamaguchi discloses an adhesive composition comprising SBS and polyvinyl Butyral which provides for tackiness (col. 3, lines 5, 10, and 15). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Yamaguchi's teaching of using polyvinyl Butyral in the invention of Fensel' adhesive composition with the motivation to provide for enhanced tackiness to the adhesive composition.

4. Claims 11, 28 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fensel in view of Braga and Phillips (5916654).

Fensel and Braga, as discussed above, fails to teach that the release liner is a polyester, polyethylene or polypropylene film. Phillips discloses a modified bitumen adhesive covered with a release liner which can be of polyester, polyethylene or polypropylene (col. 3, lines 11-17). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Phillips' teaching of using polymer film as release liner in

the invention of Fensel with the motivation to provide for adhesive surface protection with liner of increased strength.

5. Claims 16 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fensel in view of Braga and Zickell (4992315).

Fensel and Braga, as discusses above, fails to teach that the carrier is polyester mat. Zickell that polyester mat is an equivalent structure known in the art (col. 3, lines 25-29). Therefore, because these two polyester and fiberglass were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute polyester for fiberglass.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-39 are provisionally rejected as being unpatentable over claim1-39 of copending Application No. 10/776863. Both the applications are directed to identical structures except that the application'863 recites in the preamble the phrase "A self-adhering underlayment for tile roofing assemblies", whereas the application'868 recites in the preamble "A self-adhering underlayment for metal roofing assemblies". The structures are identical when the intended use phrase is not given patentable weight.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6696125. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the Patent are directed to identical structure except that the composition recited for some components are different in the Patent. It would have been obvious to one having ordinary skill in the art to modify the Patent by providing composition, based on optimization through routine experimentation, to provide for optimum characteristics.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nasser Ahmad 9/17/05
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
September 17, 2005.